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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

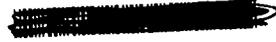
Applicant: Baby Björn AB
Serial No.: 75/751554
Trademark: Design of Baby Carrier
Examiner: Nicholas K.D. Altree, Esq.
Law Office: 108
Filing Date: July 15, 1999

Attention: Karl Kochersperger, Esq.
United States Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

APPLICANT'S REPLY BRIEF

The Examiner has refused trademark registration of Applicant's product design under Trademark Act § 2(e)(5) on the ground that the mark is functional and under Trademark Act §§ 1, 2 and 45 on the ground that the mark is a non-distinctive configuration of goods.

Applicant has appealed the Examiner's refusal and submits that Applicant's product configuration embodies a nonfunctional design which has acquired distinctiveness as a trademark. Applicant herewith responds to the Examining Attorney's Appeal Brief dated December 5, 2003 and mailed to Applicant on March 31, 2004.



ARGUMENTS

In supporting the continued functionality refusal, the Examiner has not addressed the bulk of Applicant's appeal brief arguments and evidence supporting registrability of the subject product configuration. Instead, the Examiner relies solely on the 2001 Supreme Court decision in TraFFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001) which, he states, "addressed a factual situation very similar to this case". Examining Attorney's Appeal Brief p. 6. In doing so, the Examiner refuses consideration of the Morton-Norwich factors and restricts his analysis to whether the subject configuration is encompassed by Applicant's two utility patents previously made of record.

While convenient, the Examiner's total reliance on the TraFFix opinion is misplaced. The dual-spring, windproof sign configuration at issue in the TraFFix opinion represented the central advance claimed in the corresponding utility patents. TraFFix at 30. The Court also cited specific language from the patents supporting the advantages of the particular spring configuration for which trade dress protection was claimed. TraFFix at 31.

By contrast, Applicant's patents do not disclose any

utilitarian advantages relating to the design feature for which trademark registration is sought. Although Applicant's referenced patents include images of a carrier flap design matching Applicant's trademark drawing page, the particular shape of the flap is clearly not dictated by the patent. Instead, the product portion for which trademark protection is claimed is described generically as a flap or pouch, with no reference to its shape.

Courts have acknowledged that the facts of TrafFix present "an easy case of functionality, based on considerations other than alternative designs". Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co., 69 USPQ2d 1493, 1502 (S.D.N.Y. 2003). In the absence of such facts, other factors, such as the availability of alternative designs, remain a "legitimate source of evidence to determine whether a feature is functional in the first place". Id. citing Valu Engineering, Inc. v. Rexnord Corporation, 278 F.3d 1268, 1276 (Fed. Cir. 2002).

In addition, as instructed in the Trademark Manual of Examining Procedure, "[i]t is important to read the patent to determine whether the patent actually claims the features presented in the proposed mark. If it does not, or if the features are referenced in the patent, but only as arbitrary or

incidental features, then the probative value of the patent as evidence of functionality is substantially diminished or negated entirely." TMEP § 1202.02(a)(v) citing TraFFix, 532 U.S. at 34 (where a manufacturer seeks to protect arbitrary, incidental or ornamental aspects or features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, functionality will not be established if the manufacturer can prove that those aspects do not serve a purpose within the terms of utility patent); see also Black & Decker Inc. v. Hoover Service Ctr., 886 F.2d 1285, 12 USPQ2d 1250 (Fed. Cir. 1989); In re Zippo Mfg. Co., 50 USPQ2d 1852 (TTAB 1999); In re Weber-Stephen Products Co., 3 USPQ2d 1659 (TTAB 1987).

As previously stated, Applicant is neither seeking, nor is entitled to, exclusive rights to the use of a fabric support flap for baby carriers. Applicant instead seeks registration of a particular flap shape comprising a specific combination of curves, lines and stripes. The Examiner has not shown how this particular combination is essential to the use or purpose of Applicant's products or how the registration of Applicant's particular design would hinder competition. Moreover, the Examiner's repeated reference to the April 24, 2002 Office Action

purporting to highlight functional aspects of adjustable straps and clasps covered by Applicant's patents overlooks that such elements are clearly disclaimed from the subject mark.

The Examiner also points to Applicant's "admission" that its baby carrier product includes certain functional elements and aspects combined in a non-functional manner. The Examiner appears to regard such a non-functional compilation of elements as a legal impossibility, and describes as a "fundamental flaw" Applicant's assertion that the arbitrary shape of its baby carrier flap design is entitled to trademark protection notwithstanding the load bearing function of the flap. According to the Examiner, product shape and function are inseparable concepts such that a trademark owner may be presumed to choose a particular product shape solely for utilitarian purposes.

This analysis rejects the well-established concept of *de facto* functionality, which holds that the design of a product may have a function while still being capable of trademark protection. See Valu Engineering, Inc., 278 F.3d at 1274. As discussed in Applicant's appeal brief, the issue to be determined is not whether baby carriers are functional or how they are used, but whether the particular design of the flap portion of Applicant's baby carrier is functional as a matter of law, *i.e.*,

whether it is essential to the use or purpose of baby carriers or affects the cost or quality of baby carriers. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 7:70 (4th ed. 2002), citing Disc Golf Ass'n Inc. v. Champion Discs, Inc., 158 F.3d 1002 (9th Cir. 1998).

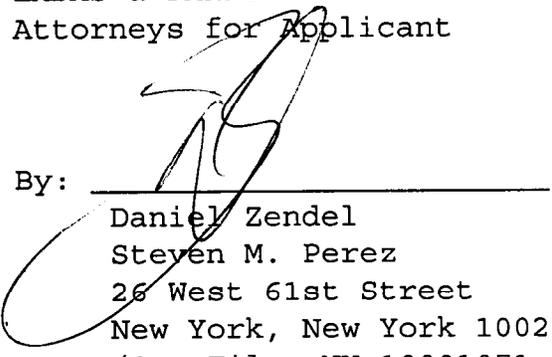
Applicant's configuration, as amended in the Request for Reconsideration, embodies a nonfunctional design capable of distinguishing Applicant's goods from those of competing designs. Accordingly, and in light of evidence made of record in Applicant's prior Responses, Request for Reconsideration and Appeal Brief, the refusal to register Applicant's product configuration under Trademark Act § 2(e)(5) and under Trademark Act §§ 1, 2 and 45 should be reversed. Applicant respectfully requests return of jurisdiction in this matter to the Examining Attorney and an early notice of publication.

Respectfully submitted,

LADAS & PARRY
Attorneys for Applicant

Date: April 20, 2004

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INDEX OF CASES

Applicant's Appeal Brief and Reply Brief

- Black & Decker Inc. v. Hoover Service Ctr., 886 F.2d 1285, 12 USPQ2d 1250 (Fed. Cir. 1989)
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- Clicks Billiards, Inc. v. Sixshooters Inc., 251 F.3d 1252 (2001)
- Coach, Inc. v. We Care Trading Co., Inc., 2001 U.S. Dist. LEXIS 9879 (2001)
- Disc Golf Ass'n Inc. v. Champion Discs, Inc., 158 F.3d 1002 (9th Cir. 1998)
- Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co., 69 USPQ2d 1493 (S.D.N.Y. 2003)
- TraFFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001)
- In re Ennco Display Systems Inc., 56 U.S.P.Q.2d 1279 (T.T.A.B. 2000);
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- In re Morton-Norwich Products, Inc., 671 F.2d 1332 (C.C.P.A. 1982)
- In re Parkway Machine Corp., 52 U.S.P.Q.2d 1628 (T.T.A.B. 1999)
- In re R.M. Smith, Inc., 734 F.2d 1482, 222 U.S.P.Q. 1 (Fed. Cir. 1984);
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In re Zippo Mfg. Co., 50 USPQ2d 1852 (TTAB 1999);

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Metrokane, Inc. v. The Wine Enthusiast, 160 F.Supp.2d 633 (S.D. NY 2001).

Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995),

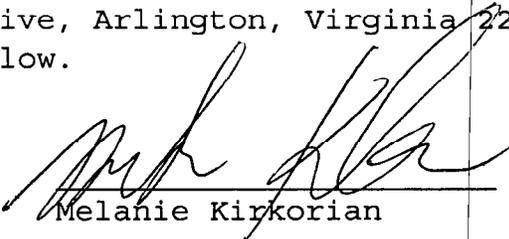
Roux Laboratories Inc. v. Clairol Inc., 427 F.2d 823 (C.C.P.A. 1970).

Valu Engineering, Inc. v. Rexnord Corporation, 278 F.3d 1268 (Fed. Cir. 2002).

Yamaha International v. Hoshino Gakki, 840 F.2d 1572 (Fed. Cir. 1988).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on the date appearing below.



Melanie Kirkorian

April 20, 2004
Date